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PTO/SB/33 (07/05)

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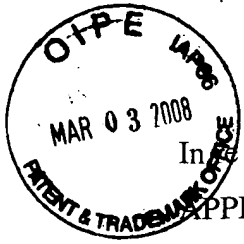
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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) | |
|--|--|--|--|
| | | 879A.0048.U1(US) | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR on _____ Signature _____ Typed or printed name <u>Ann Okrentowich</u> | Application Number | Filed | |
| | 10/645,687 | 8/20/2003 | |
| | First Named Inventor | | |
| | Simelius, Kim | | |
| | Art Unit | Examiner | |
| | 2165 | Syed, F. M. | |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. | | | |
| This request is being filed with a notice of appeal. | | | |
| The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. | | | |
| I am the | |  | |
| <input type="checkbox"/> | applicant/inventor. | Signature | |
| <input type="checkbox"/> | assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | Walter J. Malinowski | |
| | | Typed or printed name | |
| <input checked="" type="checkbox"/> | attorney or agent of record. Registration number <u>43,423</u> | (203) 925-9400 | |
| | | Telephone number | |
| <input type="checkbox"/> | attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | <u>Feb. 27, 2008</u> | |
| | | Date | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*. | | | |

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE U.S. PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

APPLICANT: Kim Simelius

SERIAL NO.: 10/645,687

FILING DATE: August 20, 2003

EXAMINER: Syed, Farhan M.

ART UNIT: 2165

ATTORNEY'S DOCKET NO.:

879A.0048.U1(US)

TITLE:

METHOD AND APPARATUS FOR DATA TRANSMISSION

PRE-APPEAL BRIEF REQUEST FOR REVIEW ATTACHMENT

The following is a concise recitation of two clear errors in the Examiner's rejections in this application.

1. In the Final Office Action of November 27, 2007, the Patent Office rejected claims 1-22 under 35 U.S.C. 102(b) as being anticipated by Celik, U.S. Published Patent Application No. 2004/0236792 and claims 1-22 under 35 U.S.C. 103(a) as being unpatentable over Alam, U.S. Patent No. 6,324,544, in view of Champagne, U.S. Published Patent Application No. 2005/0086199, (for claims 9-11 and 21 in further view of Huskin, U.S. Patent No. 6,141,663).

ERROR I: FAILURE TO TREAT ALL CLAIM LIMITATIONS

It was a first clear error on the part of the Patent Office to not identify with specificity where in the prior art reference the claimed subject matter of both an "existing grouping identifier" and a "new grouping identifier" is disclosed.

Regarding the "grouping identifier" and "data item," the Patent Office asserted in lines 1-3 of page 20 of the Final Office Action dated November 27 2007 as follows: "The Examiner refers to Figures 1, 2A, and 2B. The grouping identifier is the unique user identifier and the data item is the personal information that is targeted to be synced as described in Figures 1, 2A, and 2B."

Does the Patent Office mean that the "ID Number" is the grouping identifier? If so, then how does Celik account for "an existing grouping identifier" as well as "a new grouping identifier?" And, how would one of ordinary skill select between the existing grouping identifier and the new grouping identifier? On page 3, lines 4-6, of the Final Office Action dated November 27 2007, the Patent Office asserted "selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a

selected grouping identifier, synchronizing said data items” as being taught by Celik, presumably in Figure 2B (line 8, on page 3 of that Final Office Action).

Figure 2B of Celik shows ‘120’ for ‘Assign account and unique ID’ and ‘130’ for “Print business cards with IDs (barcode optional).’ There does not appear to be any selection, as recited in the claims, between an “existing grouping identifier” and a “new grouping identifier.”

The Patent Office, on pages 2-3, of the Final Office Action dated November 27 2007, refers to paragraphs [0041]-[0043] of Celik (same as col. 5, line 65 – col. 7, line 34 of the Celik’s patent US6374259) with respect to the following features of the independent claims of the present application:

“in response to a situation in which the user associates said existing grouping identifier for the formed data item, associating the formed data item with said existing grouping identifier, said existing grouping identifier being associable with at least one other data item, in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, obtaining a new grouping identifier and associating the formed data item with the new grouping identifier,”

The Patent Office does not specify which feature or element recited in paragraphs [0041]-[0043] of Celik and that would correspond to the existing grouping identifier” and/or to “the new grouping identifier” recited in the above features.

Applicant could not find any other interpretation except that the Patent Office considers a “password” mentioned in the above passages of Celik as corresponding to the “existing grouping identifier” and/or to “the new grouping identifier” recited in the above features. In the paragraphs [0041]-[0043] of Celik, the password is an element that can be established and changed by a user (changing = creating a new password that replaces an old one).

However, if the “existing grouping identifier” and/or “the new grouping identifier” recited in the above features are made to correspond to the password, the following features of the independent claims are not taught by Celik (added remarks are in brackets):

“selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping

identifier [when a new password is created it replaces the old one, therefore an “existing password” and a “new password” cannot not be available for selection], and synchronizing said data items between said first electronic device and a second electronic device on the basis of said selected grouping identifier, said devices being capable of communication with each other

[Celik does not teach to synchronize electronic devices on the basis of a password].”

Therefore, Celik does not teach all the limitations of the independent claims of the present application. Hence, the teaching of Celik does not anticipate the independent claims.

As such, Celik cannot anticipate claims 1-22.

ERROR II: MISAPPLICATION OF 35 USC 102(b) AND FAILING TO ATTRIBUTE SIGNIFICANCE TO NEWLY ADDED SUBJECT MATTER IN A CONTINUATION-IN-PART PATENT APPLICATION

It was a second clear error for the Patent Office to first treat Celik, U.S. Published Patent Application No. 2004/0236792 as a 35 U.S.C. 102(b) reference and second not to segregate out subject matter commonly disclosed by Celik, U.S. Published Patent Application No. 2004/0236792, but not disclosed by earlier patent applications from which Celik claims priority.

Celik, U.S. Published Patent Application No. 2004/0236792, is not a 35 U.S.C. 102(b) reference. It cannot be because it was not published or patented more than one year before the effective filing date of Applicant’s patent application. **The effective filing date of a reference, not the application being examined, is irrelevant for the purposes of applying sub-section b) of 35 U.S.C. 102.**

MPEP § 706.02(a) states “If the publication or issue date of the reference is more than 1 year prior to the effective filing date of the application (MPEP § 706.02), the reference qualifies as prior art under 35 U.S.C. 102(b).” As Celik, U.S. Published Patent Application No. 2004/0236792, was not published until November 25 2004, it cannot be a 35 U.S.C. 102(b) reference against Applicant’s current patent application.

As far as to whether U.S. Patent No. 6,374,529, may apply, the matter is moot as the Patent Office has not applied this reference.

Because, as the Patent Office correctly noted on page 19 of the Final Office Action dated November 27 2007, where Figures 1-8 of Celik, U.S. Published Patent

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Art Unit: 2165

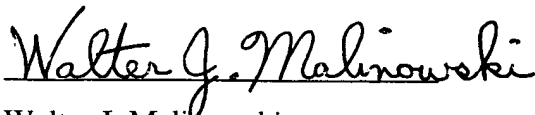
Application No. 2004/0236792, and Figures 1-8 of Celik, U.S. Patent No. 6,374,259, form common subject matter, that commonly disclosed subject matter would be accorded the benefit of the filing date of the earlier of the two (i.e., Celik, U.S. Patent No. 6,374,259).

MPEP § 201.11 states as follows:

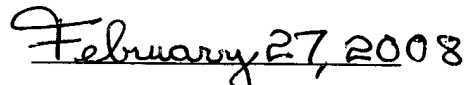
Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. The statute is so worded that the prior application may contain more than the later-filed application, or the later-filed application may contain more than the prior application, and in either case the later-filed application is entitled to the benefit of the filing date of the prior application as to the common subject matter disclosed in compliance with 35 U.S.C. 112, first paragraph.

As such, as pointed out on pages 9-10 of our response of September 17 2007, paragraphs 0065-0070 of Celik, U.S. Published Patent Application No. 2004/0236792 were newly added and so cannot qualify as prior art to reject the claims. Yet the Patent Office did just this for claims 8, 9, 10, 12, 20, and 21, in the Final Office Action dated November 27 2007.

Respectfully submitted:



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